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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,163	02/27/2002	Akira Hokazono	220110US2S	7464
22850	7590	02/13/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DICKEY, THOMAS L	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

OK

Advisory Action

Application No.

10/083,163

Applicant(s)

HOKAZONO, AKIRA

Examiner

Thomas L Dickey

Art Unit

2826

--Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

THE REPLY FILED 05 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

NATHAN J. FLYNN

**SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: 23-44.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Minhloan Tran
**Minhloan Tran
Primary Examiner
Art Unit 2826**

Continuation of 2. NOTE: On 3/19/03 Applicants received notice that certain subject matter was allowable against art available on that date. On 6/12/03 Applicants amended their claims, effectively canceling the subject matter that had been indicated allowable. Applicants chose instead to pursue patentability on a different course. On 9/4/03 the claims Applicants presented on 6/12/03 were rejected, a final rejection. Applicants now wish to resurrect the subject matter they gave up when they amended their claims on 6/12/03.

A lot has happened since 3/19/03. For one thing, U.S. applications applied for after 9/18/01 but before 12/06/01 (applicants' effective filing date) underwent Pre-Grant Publication. Various U.S. patents filed before 12/06/01 issued, having not been previously published for various reasons. Furthermore, on 3/19/03 only dependent claims 9, 10, 20, and 21 were indicated allowable. Most of the subject matter of these claims was disclosed by KADOSH et al. (5,818,069), which anticipated parent claims 1 and 12. Whether the subject matter of original claims 9, 10, 20, and 21 is obvious over Kadosh et al. viewed in the light of some hitherto unpublished reference is a close question.

Amended claims 1 and 12, and new claims 45 and 54, present issues not considered on 9/4/03. Applicants had the option of presenting claims 1, 12, 45, and 54 in their present form prior to the 9/04/03 Final Rejection. Applicants chose not to exercise that option at that time. To allow Applicants to exercise that option at this date would present issues that would require burdensome new search and/or consideration.